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EXAMINER

DENNISON, JERRY B

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/612,632	Applicant(s) STOCHOSKY, MICHAEL	
	Examiner J Bret Dennison	Art Unit 2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/27/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to Application Number 10/612,632 received on 31 March 2008
2. Claims 1-44 are presented for examination.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide proper antecedent basis for a computer program product comprising a computer-readable medium as disclosed in claims 33-41.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-21 and 42-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. Claim 1 includes a system comprising a sender peer and a recipient peer, with each peer comprising modules.

Applicant's specification recites, "In general, a peer is some type of computing device (physical or **virtual**)" [See Applicant's specification, page 8, paragraph 0026].

Microsoft Computer Dictionary defines a virtual device as follows: "A device that can be referenced but that does not physically exist."

Therefore, Applicant's specification provides evidence showing that Applicant intends the system of claim 1 to include strictly software (i.e. software system).

6. Claim 42 includes a "recipient chat module" in a system, the recipient chat module comprising a communications module, a graphical user interface module, and a client module.

Applicant's specification provides evidence that Applicant intends this recipient chat module to include software modules [see Applicant's specification, page 10, paragraph 32 through page 11 paragraph 35]. Therefore, the "system" of claim 42 is not limited to statutory subject matter, since it includes strictly software (i.e. software system).

7. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs are not physical "things". They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

M.P.E.P. 2601.1 Section I states, "Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material."

8. Claims 1-21 and 42-44 do not provide the computer-readable medium needed to realize the program's functionality. As such, claims 1-21 and 42-44 are not limited to statutory subject matter and are therefore non-statutory.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-6, 8, 18-24, 27-35, 37-42, and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. (U.S. 2003/0225834).

11. Regarding claims 1 and 33, Lee disclosed a system for sharing information about an active content of a sender peer with a recipient peer (Lee, [0008], "shared dynamic content experience between the inviter computer and the invitee computer"), comprising:

a sender peer (Lee, [0044], "client 20a" is referred to as an inviter client)

comprising:

a first application module, for activating and outputting active content from a data file (Lee, [0042], [0050], “media player 26a” for providing “a dynamic content experience” i.e. used to play mp3s);

a first chat module (Lee, [0041], “online messenger 24a”), communicatively coupled to the first application module, the first chat module adapted to send the active content (Lee, [0047], Fig. 4, Messenger Service 300 containing Start Music Play button 304, which starts a shared dynamic session and sharing music) using a chat module communications path (Lee, Fig. 2, 30 is a communications path from the chat module 20a to chat module 20b); and a recipient peer (Lee, [0044], “client 20b” referred to as an invitee client) comprising:

a second chat module (Lee, [0041], “online messenger 24b”), communicatively coupled to the first chat module using the chat module communications path (Lee, Fig. 2, 30 is a communications path from the chat module 20a to chat module 20b), for receiving and outputting the active content active on the sender peer (Lee, [0055]-[0057], Lee disclosed the online messenger program and media player integrated together to receive and output shared music).

Claim 33 includes a computer program product containing a computer-readable medium that includes limitations that are substantially similar to the limitations of claim 1. Lee disclosed a computer readable medium (Lee, [0028]) performing the

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functionality of the claim. The pre-established path in Lee is the path 30 from client 20a to client 20b in Figure 2. Therefore claim 33 is rejected under the same rationale.

12. Regarding claim 2, Lee disclosed the limitations, substantially as claimed, as described in claim 1, including wherein the second chat module further comprises a client module for requesting a stream of the active content and the first chat module further comprises a server module for sending the stream of active content in response to the request (Lee, [0075]; “dynamic download” i.e. streaming, [0078], “request” action can be sent before content is sent for a given file).

13. Regarding claim 3, Lee disclosed the limitations, substantially as claimed, as described in claim 2, including wherein the recipient peer further comprises a second application module for automatically activating the active content stream (Lee, [0075], media player can begin playing the dynamic media before it is completely downloaded, with the media player determining when to start playing the stream).

14. Regarding claim 4, Lee disclosed the limitations, substantially as claimed, as described in claims 3, including wherein the stream is substantially synchronized with a portion of the active content currently active to the first application module (Lee, [0072]).

15. Regarding claim 5, Lee disclosed the limitations, substantially as claimed, as described in claim 4, including wherein the second application module allows active

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content playback control independent from the synchronized stream (Lee, [0073], Lee disclosed allowing the invitee to skip, pause or stop playback of the stream).

16. Regarding claim 6, Lee disclosed the limitations, substantially as claimed, as described in claim 1, including wherein the active content information comprises a unique identifier (Lee, [0078], “unique identifier for the file”).

17. Regarding claim 8, Lee disclosed the limitations, substantially as claimed, as described in claim 6, including wherein the recipient peer uses the unique identifier to retrieve active content information from an active content enhancement server ([0050], Lee disclosed that “the audio files can be stored remotely from the inviter computer, and retrieved when the user selects them to be played”; [0078], Lee disclosed requesting the files using a unique identifier).

18. Regarding claim 18, Lee disclosed the limitations, substantially as claimed, as described in claim 1, including wherein the active content comprises a title and a type of the active content (Lee, [0077]).

19. Regarding claim 19, Lee disclosed the limitations, substantially as claimed, as described in claim 1, including wherein the first chat module is an instant messaging application (Lee, [0045]).

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20. Regarding claim 20, Lee disclosed the limitations, substantially as claimed, as described in claim 1, including wherein a display of the first chat module is integrated within a display of the first application module (Lee, Fig. 4, 300, 400).

21. Regarding claim 21, Lee disclosed the limitations, substantially as claimed, as described in claim 1, including wherein the first chat module sends updated active content information to reflect a change of active content (Lee, [0072], [0097], Lee disclosed the sending machine may update the playlist, which causes a change in the content shared by the users).

22. Regarding claim 22, Lee disclosed a method for sharing active content of a first peer with a second peer, comprising:

activating media content from a data file at a sender peer (Lee, [0042], [0050], “media player 26a” for providing “a dynamic content experience” i.e. used to play mp3s);

sending real time active media content from the sender peer to a recipient peer through a chat network connection responsive to detecting active media content on the sender peer (Lee, [0097], Lee disclosed when the sender updates the playlist by changing or adding songs, the receiver playlist gets updated as well; [0047], Fig. 4, Lee disclosed the Messenger Service 300 integrated with media player 400); and

receiving and outputting the active media content at the recipient peer (Lee, [0097], Lee disclosed when the sender updates the playlist by changing or adding songs, the receiver playlist gets updated as well; [0047]).

23. Regarding claim 23, Lee disclosed the limitations, substantially as claimed, as described in claim 22, including streaming the active media content from the sender peer to the recipient peer (Lee, [0075], “dynamic downloading”).

24. Regarding claim 24, Lee disclosed the limitations, substantially as claimed, as described in claim 23, including activating the active media content stream substantially in real time with the activated media content at the recipient peer (Lee, [0075], media player can begin playing the dynamic media before it is completely downloaded, with the media player determining when to start playing the stream).

25. Regarding claim 27, Lee disclosed the limitations, substantially as claimed, as described in claim 22, including sending transaction information related to the active media content to the recipient peer responsive to the recipient peer receiving active media content (Lee, [0062], Lee disclosed sending a user a subscription user interface if the capability requires a paid subscription);

and processing a transaction related to the transaction information (Lee, [0062], Lee disclosed enabling the user if paid).

26. Regarding claim 28, Lee disclosed the limitations, substantially as claimed, as described in claim 27, including wherein the transaction is a purchase of the active

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media content (Lee, [0063], using the content sharing service is a paid subscription service).

27. Regarding claim 29, Lee disclosed the limitations, substantially as claimed, as described in claim 22, including wherein the activating comprises a first media player activating media content (Lee, [0052]), and the receiving comprises a chat module receiving active media content (Lee, Fig. 7, 700 and 750).

28. Regarding claim 30, Lee disclosed the limitations, substantially as claimed, as described in claim 22, including wherein the active media content is an audio file (Lee, [0050], sharing mp3).

29. Regarding claim 31, Lee disclosed the limitations, substantially as claimed, as described in claim 22, including wherein the active media content comprises a title and a type of the active media content (Lee, [0077]-[0078]).

30. Regarding claim 32, Lee disclosed the limitations, substantially as claimed, as described in claim 22, including updating active media content at the recipient peer responsive to a change of active media content at the sender peer (Lee, [0072], [0097], Lee disclosed the sending machine may update the playlist, which causes a change in the content shared by the users).

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31. Regarding claim 34, Lee disclosed the limitations, substantially as claimed, as described in claim 33, including instructions and data for: streaming the active content through the peer-to-peer network to the recipient peer (Lee, [0075]).

32. Regarding claim 35, Lee disclosed the limitations, substantially as claimed, as described in claim 34, including instructions and data for: activating the active content stream at the sender peer (Lee, [0076]-[0078], pushing the data to the recipient).

33. Regarding claim 37, Lee disclosed the limitations, substantially as claimed, as described in claim 33, including sending transaction information related to the active media content to the recipient peer responsive to the recipient peer receiving active media content (Lee, [0062], Lee disclosed sending a user a subscription user interface if the capability requires a paid subscription);

and processing a transaction related to the transaction information (Lee, [0062], Lee disclosed enabling the user if paid).

34. Regarding claim 38, Lee disclosed the limitations, substantially as claimed, as described in claim 37, including wherein the transaction is a purchase of the active media content (Lee, [0063], using the content sharing service is a paid subscription service).

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35. Regarding claim 39, Lee disclosed the limitations, substantially as claimed, as described in claim 33, including wherein the activating comprises a first media player activating media content (Lee, [0052]), and the receiving comprises a chat module receiving active media content (Lee, Fig. 7, 700 and 750).

36. Regarding claim 40, Lee disclosed the limitations, substantially as claimed, as described in claim 22, including wherein the active content comprises an active media content (Lee, [0050], mp3).

37. Regarding claim 41, Lee disclosed the limitations, substantially as claimed, as described in claim 33, including updating active media content at the recipient peer responsive to a change of active media content at the sender peer (Lee, [0072], [0097], Lee disclosed the sending machine may update the playlist, which causes a change in the content shared by the users).

38. Regarding claim 42, Lee disclosed a recipient chat module ([0041], "online messenger 24b) in a system for sharing active content between a plurality of peers ([0054], contacts on the list of the messenger service sharing an audio experience), comprising:

a communications module for receiving a one or more unique identifiers based on shared active content on one or more sender peers (Lee, [0078], Lee disclosed the receiving machine making requests for the content using a unique identifier to identify

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the file) wherein receiving comprises receiving using a communications module communication path (Lee, Fig. 2, path 30);

a graphical user interface module for outputting one or more shared active content and receiving a selection of shared active content associated with one of the one or more sender peers (Lee, Fig. 4, media player 400, for sending and receiving shared audio content);

and a client module for sending a content stream request (Lee, [0078], "request" for data) and receiving an active content stream (Lee, [0075], "dynamic downloading") wherein receiving comprises receiving using a communications module communication path (Lee, Fig. 2, path 30).

39. Regarding claim 44, disclosed the limitations, substantially as claimed, as described in claim 42, including an application module for activating the received active content stream (Lee, [0042] media player 26b on the receiving end).

Claim Rejections - 35 USC § 103

40. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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41. Claims 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (U.S. 2003/0225834).

42. Regarding claim 7, Lee disclosed the limitations, substantially as claimed, as described in claim 6, wherein the recipient peer further comprises a content database (Lee, [0079], virtual memory, cache, that stores tracks). Lee also disclosed the recipient machine using a unique identifier to identify files (Lee, [0078]) and the sending machine “knows” which tracks are currently stored on the receiving machine (Lee, [0079]).

Lee did not explicitly state wherein the second chat module is configured to use the unique identifier to retrieve local active content from the content database.

However, since the sending machine “knows” what tracks the receiving machine has stored and “knows” that it does not need to send these tracks, it would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention that the receiving machine retrieves the tracks that it has stored in memory, using the unique identifier as used to identify the file, for the benefit of limiting or minimizing the amount of traffic between machines (Lee, [0079]).

43. Claims 9-11, 13-17, 25-26, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (U.S. 2003/0225834) in view of Elgen (U.S. 7,080,030).

44. Regarding claims 9, 25, 36 Lee disclosed the limitations, substantially as claimed, as described in claims 1, 22, and 33. Lee also disclosed the sharing

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experience can be implemented as a paid subscription service in which a subscription user interface would be provided to the client (Lee, [0062]). Lee also disclosed that the audio files can be stored remotely from the clients (Lee, [0050]).

Lee did not explicitly state further comprising an active content enhancement server, communicatively coupled to the second chat module, for providing supplements related to the active content by query.

However, since Lee suggested storing files remotely from the clients, as well as integrating a paid subscription service, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a remote server for providing these features.

In an analogous art of providing multimedia, Eglen disclosed a database server the includes a music database that stores information about content stored on the file servers of the system (Eglen, Fig. 2, database server 208, music database 225; col. 9, lines 24-25; col. 10, lines 9-16). Eglen provides users with access to this music database by request of a web page (Eglen, col. 10, lines 45-50), and the system generates a webpage that provides the requested information from the particular database (Eglen, col. 10, lines 55-65). Eglen disclosed that each item in the database contains a unique identifier, "media ID" field (Eglen, col. 11, lines 20-21) within a media information table (Eglen, col. 11, lines 4-15).

Lee suggests the use of a remote system to provide features such as audio file storage. Eglen provides such a system that not only stores the audio content in its file

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servers, but also provides supplemental information about each file (Elgen, col. 10, lines 10-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Elgen into the system of Lee to enable users to find out information about music that a friend would like to share with them before starting the shared session, thereby allowing them to determine whether or not they would be interested in such music.

45. Regarding claim 10, Lee and Elgen disclosed the limitations, substantially as claimed, as described in claim 9, including wherein the content enhancement server further comprises a content transaction module for processing a purchase related to one or more sources containing the active content (Elgen, Figs. 12A and 12B, Elgen disclosed allowing clients to purchase music). See motivation above.

46. Regarding claim 11, Lee and Elgen disclosed the limitations, substantially as claimed, as described in claim 9, including wherein the active content enhancement server further comprises a content supplement database containing supplemental information related the active content (Elgen, col. 10, lines 9-16, music database). See motivation above.

47. Regarding claim 13, Lee and Elgen disclosed the limitations, substantially as claimed, as described in claim 9, including wherein the sender peer and the recipient

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peer are communicatively coupled through a first network (Lee, Fig. 2, network 70), and the recipient peer and the content enhancement server are communicatively coupled through a second network (Lee, Fig. 2, network 60). See motivation above.

48. Regarding claim 14, Lee and Elgen disclosed the limitations, substantially as claimed, as described in claim 9, including wherein the sender peer further comprises a content repository for storing content activated by the first application module (Lee, [0050], audio files stores on inviter computer). See Motivation above.

49. Regarding claim 15, Lee and Elgen disclosed the limitations, substantially as claimed, as described in claim 9, including wherein the first application module comprises a first media player (Lee, [0042], "media player 20a), the second application module comprises a second media player (Lee, [0042], "media player 20b), and a file format of the active content is compatible with the second application module (Lee, [0050], content sharing mode supports well-known .mp3 and .wma formats). See Motivation above.

50. Regarding claim 16, Lee and Elgen disclosed the limitations, substantially as claimed, as described in claim 15, including, wherein the active content comprises an active media (Lee, [0050], shared content includes well-known .mp3 and .wma formats). See Motivation above. See Motivation above.

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51. Regarding claim 17, Lee and Elgen disclosed the limitations, substantially as claimed, as described in claim 16, including wherein the active media comprises one from the group consisting of an audio file and a video file (Lee, [0050], shared content includes well-known .mp3 and .wma formats). See Motivation above.

52. Regarding claim 26, Lee and Elgen disclosed the limitations, substantially as claimed, as described in claim 25, including wherein the supplemental information includes graphic files related to the active media (Elgen, col. 10, lines 10-15, “album picture”). See motivation above.

Claims 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (U.S. 2003/0225834) in view of Wiser et al. (U.S. 6,385,596).

53. Regarding claim 43, disclosed Lee disclosed the limitations, substantially as claimed, as described in claim 42, including wherein the content stream request comprises the unique identifier ([0078] “unique identifier for the file”). Lee also disclosed the sharing experience can be implemented as a paid subscription service in which a subscription user interface would be provided to the client (Lee, [0062]). Lee also disclosed that the audio files can be stored remotely from the clients (Lee, [0050]).

Lee did not explicitly state wherein the recipient chat module sends the content stream request to a content enhancement server containing previews of the associated active content.

However, since Lee suggested storing files remotely from the clients, as well as integrating a paid subscription service, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a remote server for providing these features.

In an analogous art of online music distribution, Wiser disclosed a music distribution system (Wiser, col. 3, lines 10-15) that provides users with un-encrypted versions of a song that may be a portion of the song in which the consumer can preview the song before purchasing (Wiser, col. 3, lines 55-62).

Lee suggests the use of a remote system to provide features such as audio file storage. Wiser provides such a system that not only stores the audio content, but also provides supplemental information about each song including a free preview of the song (Wiser, col. 3, lines 55-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Wiser into the system of Lee to enable users to find out information as well as listen to a preview of the music that a friend would like to share with them before starting the shared session, thereby allowing them to determine whether or not they would be interested in such music before initiating the shared session.

54. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (U.S. 2003/0225834) and Elgen (U.S. 7,080,030) as applied to claim 9 above, and further in view of Wiser et al. (U.S. 6,385,596).

55. Regarding claim 12, Lee and Elgen disclosed the limitations, substantially as claimed, as described in claim 9. Elgen also disclosed wherein users can request information about music files and if interested, be able to purchase them through the system's webpage (Elgen, col. 10, lines 10-15, 45-50, 56-65; Fig. 24A, 24B), as well as storing each item with a unique identifier (Elgen, col. 11, lines 20-21). See motivation to combine above.

Lee and Elgen did not explicitly state a content repository containing previews related to the one or more sources containing the active content, and the active supplement database streams an active content preview to the recipient peer.

In an analogous art of online music distribution, Wiser disclosed a music distribution system (Wiser, col. 3, lines 10-15) that provides users with un-encrypted versions of a song that may be a portion of the song in which the consumer can preview the song before purchasing (Wiser, col. 3, lines 55-62).

Both Elgen and Wiser provide online music distribution systems that provide the user with information about items to help them make a decision as to whether to purchase the item. Wiser not only provides the information that Elgen provides (Wiser, col. 3, lines 61-63), but also takes this one step further as to actually allowing the user to preview the song (Wiser, col. 3, lines 55-63).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the previewing feature of Wiser into the

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distribution system of Elgen to provide the extra feature of letting the consumer listen to a song to help the consumer decide whether or not to purchase the high fidelity version

Response to Arguments

56. Applicant's arguments filed 3/31/2008 have been considered but they are not fully persuasive.

Objection to the Specification

The objection to the Specification for lack of antecedent basis is maintained because while Applicant attempts to point out possible examples in Applicant's Specification, it is indeterminable exactly how a "computer product comprising a computer readable medium" is defined. The Specification does not provide the proper antecedent basis for this terminology.

Claim Rejections Under 35 U.S.C. 101

Applicant's arguments regarding the 35 U.S.C. 101 Rejections are not persuasive.

Applicant argues that the virtual embodiment does not change the fact that the Specification describes that a peer may be a physical device.

Examiner completely agrees. But the problem is that the claim may be limited to a software embodiment. The claim must be amended in order for it to not be read on the software embodiment. By Applicant providing a claim that is broad enough to read on a software embodiment, it clearly shows that Applicant intends coverage on the software embodiment. However this is not allowed as it is non-statutory subject matter. It is recommended by Examiner that Applicant amend the claim in order to only claim

the hardware embodiment. What Examiner means by the use of "strictly software" is that there is an embodiment that may be limited to strictly software, i.e. no hardware.

Regarding claim 42, Applicant asserts, "the claim specifically calls for the recipient chat module comprising a communications module and a client module, clearly these modules include embodiments that have physical entities and thus the recipient chat module is clearly not solely a software module" [Response, p 12].

Examiner disagrees. The Applicant has not provided any evidence from the Specification to support this statement. It is clear from the claim that the functionality may be performed in software alone, and it is also clear that there is absolutely no hardware claimed.

Claim Rejections Under 35 U.S.C. 102

It appears that Applicant's arguments are directed to what was discussed in the Interview, which occurred on 02 April 2009, for which Applicant stated, a preliminary amendment would be made in order to show that both chatting and the active content occur (are transmitted) along the same communications path. The Examiner explained that the claims as presented were too broad, in that they simply show a communications path between the devices sending the active content. Lee clearly shows a communications path between the two devices in Figure 2 for sending the active content. As indicated in the previous office action, and as can be seen by the Picture on the front page of Lee (i.e. Fig. 3), both the online messenger program and the media player are integrated together, for example, see 304 and 302. However, no amendments to correct this matter have been received.

Claim Rejections Under 35 U.S.C. 103

Applicant argues that the supplemental database disclosed by Elgen "does not disclose other information related to the active content as described in Applicant's Specification. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., advertisements or books) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant asserts, "the Examiner failed to identify the reasons why those skilled in the art would combine Lee and Elgen in a manner provided in claims 9-11, 13-17, 25-26 and 36. The Examiner notes that evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In this case, the reasons for combining are to enable users to find out information about music that a friend would like to share with them before starting the shared session, thereby allowing them to determine whether or not they would be interested in such music. Regarding Applicant's arguments for claims 43 and 12, Applicant argues that the combination of Lee, Elgen and Wiser in regards to claim 12, or the combination of Lee and Wiser in regards to claim 43, would not make the elements of the claims. However, Applicant has failed to explicitly point out what elements Applicant is referring. The Applicant argues that the Examiner has not

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provided sufficient motivation to combine or modify the cited references. The Examiner notes that evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In this case, the motivation to combine the teachings of Lee and Elger can be found in the rejection of claim 9. The motivation to include Wisner into the teachings described by the combination of Lee and Elger can be found in the rejection of claim 12. The motivation to combine the teachings of Lee and Wisner can be found in the rejection of claim 43.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J Bret Dennison/
Primary Examiner, Art Unit 2443